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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,503	04/11/2001	Thomas E. Benim	DP6945 US NA	2453

23906 7590 06/05/2002

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
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WILMINGTON, DE 19805

EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,503

Applicant(s)

BENIM ET AL.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to an article, classified in class 428.
- II. Claims 12-13, drawn to an article, classified in class 428.
- III. Claims 13-17, drawn to a method, classified in class 156.

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a label for anything other than a container. and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2)

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that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as adhering the thermal insulating layer and at least one face layer without the use of a heated calendar roll nip.

Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process such as adhering the thermal insulating layer and at least one face layer without the use of a heated calendar roll nip.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mrs. Hamby on May 2, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The term "so that" in claim 10 is a relative term which renders the claim indefinite. The term "so that" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3,5-6, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frankosky et al. (5527600) in view of Hobson (4871597).

Frankosky et al. discloses a thermal insulating layer having a thermal resistance in the range of 0.05 to 0.5 CLO (col. 5 lines 41-43), which is laminated to a face material (col. 2 lines 41-45), wherein the label stock is at least 0.0075 inch thick (col. 3 lines 57-58). Frankosky et al. discloses that the face material comprises a fabric and that the

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thermal insulating layer comprises a fiberfill batt (col. 3 lines 58-61). Frankosky et al. discloses that the label stock is sealed at its edges (col. 2 lines 27-28). Frankosky et al. discloses that the thermal insulating layer comprises an organic thermoplastic fiber based material comprising polyester, polyethylene or polypropylene (col. 3 lines 59-60 and col. 4 lines 11-13). Frankosky et al discloses that the insulating film is laminated to at least one sheet of coextruded film which comprises a first layer and a second layer, wherein the first layer and the second layer are made of different materials, and the second layer has a lower melting temperature the material of the first layer, so that when the face material is heated, the second layer softens and adheres to the thermal insulating layer when pressure is applied (col. 2 lines 5-14). Frankosky et al. fail to disclose that the film is made of a thermoplastic material comprising polyester, polyethylene or polypropylene. Frankosky et al. fail to disclose that the thermal insulating layer comprises foam. Hobson teaches that the film is made of a thermoplastic material comprising polyester (col. 4 line 31) for the purpose of adding strength to the structure (col.4 lines 32-33). Hobson teaches that the thermal insulating layer comprises a foam (col. 4 lines 7-10) for the purpose of serving as an insulator from convective heat transfer (col. 4 lines 7-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Frankosky et al. with a film that is made of a thermoplastic material comprising polyester in order to add strength to the structure (col.4 lines 32-33) as taught by Hobson.

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Furthermore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Frankosky et al. with a thermal insulating layer that is a foam in order to serve as an insulator from convective heat transfer (col. 4 lines 7-8) as taught by Hobson.

3. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frankosky et al. in view of Hobson and in further view of Siddiqui (5453326).

Frankosky et al. and Hobson discloses the insulating label stock as described above. Frankosky et al. and Hobson fail to disclose a coating on the face material wherein the coating is printable. Frankosky et al. and Hobson fail to disclose that the face material is modified on the surface facing away from the thermal insulating layer to facilitate printing thereon. Siddiqui teaches a coating on the face material wherein the coating is printable and that the face material is modified on the surface to facilitate printing thereon (col. 3 lines 1-6 and 21-23) for the purpose of improving ink adhesion (col. 2 lines 55-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Frankosky et al. and Hobson with a coating on the face material which is modified on the surface facing away from the thermal insulating material wherein the coating is printable in order to improve ink adhesion (col. 2 lines 55-57).

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frankosky et al. in view of Hobson and in further view of 3M Utilities and Telecommunications OEM.

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Frankosky et al. and Hobson discloses the insulating label stock as described above. Frankosky et al. and Hobson fail to disclose that the face material is modified on the surface facing away from the thermal insulating layer to facilitate bonding to another surface with an adhesive. 3M Utilities and Telecommunications OEM teaches that the face material is modified on the surface facing away from the thermal insulating layer to facilitate bonding to another surface with an adhesive for the purpose of adhering the tape to another surface (3M 55 composite film electrical tape).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Frankosky et al. and Hobson with the face material that is modified on the surface facing away from the thermal insulating layer to facilitate bonding to another surface with an adhesive for the purpose of adhering the tape to another surface (3M 55 composite film electrical tape).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-301-9999 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jane Rhee

Jane Rhee
June 3, 2002

Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
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6/2/02